

AMENDMENT UNDER 37 C.F.R. § 1.111
U.S. Appln. No. 10/041,669

REMARKS

Claims 1-27 have been examined. Claims 1, 12/1, 16-21, 26, and 27 have been rejected under 35 U.S.C. § 112, second paragraph. Also, the Examiner has indicated that claims 2-15, and 22-25 contain allowable subject matter.

I. Formal Matters

The Examiner has objected to the drawings under 37 C.F.R. § 1.83(a) because the discharging roller recited in claim 6 is not shown in the drawings. Applicant submits that the amendment to the claims overcome the objection.

II. Rejection under 35 U.S.C. § 112, second paragraph

Claims 1, 12/1, 16-21, 26, and 27 have been rejected under 35 U.S.C. § 112, second paragraph as being indefinite.

A. Claims 1, 12/1, and 27

The Examiner has rejected claims 1, 12/1, and 27 under 35 U.S.C. § 112, second paragraph, because they do not define any structure to support the functional wherein limitations. Applicant submits that the claims are definite and satisfy the requirements of 35 U.S.C. § 112.

For example, M.P.E.P. § 2173.05(g) states:

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A functional limitation is an attempt to define something by what it does, rather than by what it is (e.g., as evidenced by its specific structure or specific ingredients). There is nothing inherently wrong with defining some part of an invention in functional terms. Functional language does not, in and of itself, render a claim improper. *In re Swinehart*, 439 F.2d 210, 169 USPQ 226 (CCPA 1971).

A functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used. A functional limitation is often used in association with an element, ingredient, or step of a process to define a particular capability or purpose that is served by the recited element, ingredient or step. (Emphasis added).

Claim 1 states that, when a recording medium is not transported on a suction unit, suction ports are closed, and when the recording medium is transported on the suction unit, the suction ports are sequentially opened so as to spread a sucking area on the suction unit in accordance with transportation of a leading end of the recording medium. Such language clearly demarks the metes and bounds of the claim, and one skilled in the art would readily know whether or not such limitations read on a device.

For example, if the suction ports of a device are never closed when a recording medium is not transported on a suction unit, the device falls outside the scope of the limitations. Also, the device falls outside the scope of the limitations if the suction ports of the device are not sequentially opened, when a recording medium is transported on the suction unit, so as to spread a sucking area on the suction unit in accordance with transportation of a leading end of the recording medium.

On the other hand, if the suction ports of a device (1) are closed, when a recording medium is not transported on a suction unit, and (2) are sequentially opened in the claimed manner, when the recording medium is transported on the suction unit, the limitations read on

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the device. Accordingly, Applicant submits that the claim limitations are clear and definite under 35 U.S.C. § 112, second paragraph.

Also, the Examiner reliance on the *In re Mason* case, which was decided 45 years ago, is irrelevant as to whether or not a claim is definite under 35 U.S.C. § 112, second paragraph. Specifically, the Examiner cites the case for the proposition that “[f]unctional statement cannot serve to distinguish claims, which are not process claims, from reference since it does not define any structure.” (Office Action, page 2). As noted above, the Examiner cites *In re Mason* for the proposition that functional language cannot be used to distinguish apparatus claims from the prior art used in a rejection under 35 U.S.C. § 102 or § 103. While Applicant disagrees with the proposition, it is clearly irrelevant as to whether or not claim language is definite under 35 U.S.C. § 112, second paragraph.

In light of the discussion above, Applicant submits that claim 1 is patentable under 35 U.S.C. § 112, second paragraph. Also, Applicant submits that claims 12/1 and 27 are patentable for similar reasons.

B. Claim 16

Applicant submits that claim 16 is definite under 35 U.S.C. § 112, second paragraph, for reasons that are similar to the reasons presented above.

C. Claim 21

The Examiner contends that claim 21 is indefinite because the phrases “the sucking area” and “the suction holes” lack antecedent basis. Applicant submits that the phrase “a sucking area” in the wherein clause of claim 1 provides sufficient antecedent basis for the phrase “the sucking area” in claim 21.

Also, Applicant submits that the amendments to claim 21 provide sufficient antecedent basis for the phrase “the suction holes” and believe that such amendments do not change the scope of the claim.

D. Claim 26

Applicant submits that claim 26 is definite under 35 U.S.C. § 112, second paragraph, for reasons that are similar to the reasons presented above.

E. Claim 27

The Examiner contends that claim 27 is indefinite because the phrase “the sucking area” lack antecedent basis. Applicant submits that the phrase “a sucking area” in the wherein clause of claim 1 provides sufficient antecedent basis for the phrase “the sucking area”.

F. Claim 27/26

The Examiner maintains that claim 27/26 is indefinite because the phrase “the sucking area” lacks antecedent basis. Claim 27 does not depend upon claim 26, and thus, Applicant is unsure to which claim the Examiner is referring. Furthermore, claim 1 provides antecedent basis for the phrase “the sucking area” in claim 27, as noted above.

III. Allowable subject matter

A. Objection to claims 2-5 and 22

The Examiner has objected to claims 2-5 and 22 for being dependent upon a rejected base claim but indicates that they contain allowable subject matter. Since the rejection of base claim 1 is overcome, Applicant submits that the objection to claims 2-5 and 22 will likewise be overcome.

B. Claims 6-15 and 23-25

Claims 6-15 and 23-25 have been allowed.

IV. Conclusion

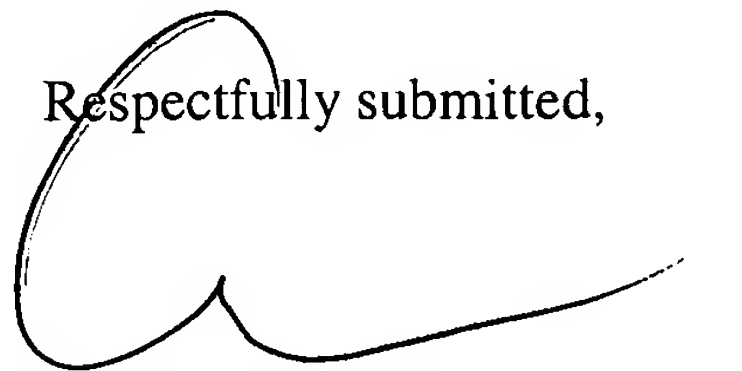
In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the

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Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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